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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,927	07/21/2005	Katja Berg-Schultz	4662-43	9534
23117 7590 05/01/2008 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
SPIELER, SHAHRZAD				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
05/01/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/542,927

**Applicant(s)**

BERG-SCHULTZ ET AL.

**Examiner**

SHAHRZAD SPIELER

**Art Unit**

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)  
Paper No(s)/Mail Date 1 sheet
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of DEA-Methoxycinnamate in the reply filed on 02/05/2008 is acknowledged. Examiner hereby withdraws species election requirement. All instant pending claims 1-8 are under prosecution in this Action.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 00/71084 to Lapidot, et al. referred to herein as "Lapidot."

4. Lapidot discloses a method for obtaining photostable sunscreen compositions using butyl methoxydibenzoylmethane (other known names: 4-tert-butyl-4'-methoxydibenzoylmethane, Avobenzone, and BMDBM) as a sunscreen active, and 2-ethylhexyl-p-methoxycinnamate (instant Formula 1, of instant claim 6) as another sunscreen active as a preferred sunscreen active (see page 1, background, and page 4, summary). Lapidot further discloses a method of microencapsulating at least one of said active ingredients in an encapsulating material suitable for holding the active, and adding another active needed for preparation of said composition. Lapidot discloses the sunscreen actives to be UVA and UVB absorbers (see page 4, summary), and the encapsulation of the sunscreen active as prepared by the sol-gel method, where the sunscreen agent is entrapped within a polymer matrix, resulting in the formation of a

Art Unit: 1612

wall, prepared by the sol-gel silica method of micro-encapsulation (see page 4 summary, page 7-8¶ 3, 4, 6, and 6 and claims, 1, 3-8 and 12-13). Lapidot further discloses where encapsulating only one or some of the active ingredients, while the other active ingredient(s) are present in the composition of a non-encapsulated form (see page 6, ¶2).

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 3, and 20 of copending Application No. 11/666666, in view of Lapidot (WO 00/71084) Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to the same sunscreen composition. The composition claimed in instant application is drawn to a cinnamate derivative encapsulated in a topical sunscreen, and at least one non-encapsulated UVA/UVB sunscreen with, for example, butyl

Art Unit: 1612

methoxydibenzoylmethane, while the co-pending application (11/666666) is drawn to a sunscreen with UVA/UVB absorption using cinnamates and dibenzoyl methanes as sunscreen actives. Claims 1, 3 and 20 of copending application contain a sunscreen composition, with UVA and UVB absorption (see claim 1) with active ingredients of cinnamates and dibenzoylmethanes (see claims 3 and 20).

7. What is lacking in copending claims of 11/666666 is the teaching of encapsulation of at least one sunscreen active.
8. The teachings of Lapidot have been discussed above.
9. It would have been obvious to one of ordinary skill in the art to combine the teachings of Lapidot and the co-pending application 11/666666, to result in the claimed invention of 10/542927, with a reasonable expectation of success. One would have been motivated to combine the teachings of Lapidot and copending application 11/666666 because Lapidot teaches the encapsulation of the sunscreen actives improves photo-stability of the composition.
10. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAHRZAD SPIELER whose telephone number is (571)270-1557. The examiner can normally be reached on Weekly 8-5.

Art Unit: 1612

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gollamudi S Kishore, Ph.D/  
Primary Examiner, Art Unit 1612

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